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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,239	09/30/2003	Masashi Morioka	243403US8	5391
22850 7590 06/08/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER JOHNS, CHRISTOPHER C				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 06/08/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/673,239

**Applicant(s)**

MORIOKA ET AL.

**Examiner**

Christopher C. Johns

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Acknowledgements***

1. This Office Action is given Paper No. 20100528 for reference purposes only.
2. This Office Action is in response to the Response to Non-Final Office Action of 24 December 2009, filed by Applicants on 19 March 2010 ("Remarks of March 2010") and the Letter Submitting Replacement Drawing Sheet, filed by Applicants on 31 March 2010.
3. Claims 15 and 19 pending.
4. Claims 15 and 19 have been examined.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 15 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.
7. Claim 15 recites "generating and transmitting...the authentication and payment message...before a next service is provided to the wireless terminal." None of the specification, claims, or drawings (as originally filed) contain support for a second service being provided to

the terminal, nor for a system that sends an authentication and payment message before providing a “next service.”

8. Claim 19 recites a similar limitation (page 3, lines 14-17 - “generate and transmit...the authentication and payment message...before a next service is provided to the terminal”), and is therefore rejected for similar reasons.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 15 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Independent claim 15’s recitation of “the authentication and payment message that is sent to the authentication and payment server” (page 2, lines 20-21) renders the claim indefinite because a person having ordinary skill in the art would not understand what “message” this refers to.

a. The claim refers to “the authentication and payment message that is sent to the authentication and payment server;” however, there is no method step preceding it that recites that an “authentication and payment message is sent to the authentication and payment server after the requested service has been provided to the wireless terminal apparatus”.

- b. On lines 17-18, there is an “authentication and payment message” that is sent to the authentication and payment server; however, this message is sent “prior to providing the requested service” (line 16).
  - c. Because a person having ordinary skill in the art would not understand which “authentication and payment message” lines 20-21 attempts to refer to, said person would not understand how to implement the claimed invention, rendering the claims indefinite.
  - d. Claim 19 contains a similar recitation and is therefore similarly rejected.
12. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though claims may be indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over IBM NewGenPay (“NewGenPay”) (as disclosed in Electronic Payment Systems for E-Commerce, Second Edition - hereafter “O’Mahony”) in view of iKP Micropayment Protocol (“iKP”) (as disclosed in O’Mahony).

15. Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over IBM in view of iKP, further in view of Admitted Prior Art (under MPEP §2144.03 C).

16. As per claim 19, NewGenPay discloses:

17. authentication and payment system (page 293, figure 7.37) including a terminal apparatus (page 293, figure 7.37, "User"), a service providing server (page 293, figure 7.37, "Vendor"), an authentication and payment server (page 293, figure 7.37, "Payment Provider 1"), and a network connecting the wireless terminal apparatus, service providing server, and authentication and payment server (page 293, "allows a user to make payments to any vendor whose payment provider is connected to the clearing network");

18. receiving, by a network transceiver of the wireless terminal apparatus from a network transceiver of the authentication and payment server, a certificate of service (page 293, figure 7.37, "daily spending certificate") including a reference amount (page 292, "daily spending certificate, which specifies the maximum amount that can be spent at any one vendor"; known as "spend\_limit" in "daily\_spend\_cert" on page 294);

19. issuing, from the network transceiver unit of the wireless terminal apparatus, a request for use of a service (page 293, figure 7.37, "Signed payment order (PO)"; known as "payment" on page 294) attached with the certificate of service (page 294, "payment = {daily\_spend\_cert, pay\_order}") to the service processing server;

20. receiving, at the network transceiver of the service providing server, the request for use of a service from the wireless terminal apparatus through the network (page 293, figure 7.37, "Signed payment order (PO)");

21. comparing, at the service providing server, the reference amount in the certificate of service with an amount of payment of the requested service (page 294, last paragraph, “amount”) to determine whether the amount of payment is less than or equal to the reference amount (page 294, ¶5 - “vendor will keep track of how much the user has spent, and provided the spending limit is not exceeded...”);

22. transmitting, from the service providing server to the authentication and payment server, an authentication and payment message (page 293, figure 7.37, “Authorization for extra amount”) prior to providing the requested service (page 295, ¶2 - “user attempts a further purchase...vendor...[responds] with a signed authorization to allow further spending”) when the comparing determines that the amount of payment of the requested service is greater than the reference amount (page 295, ¶2 - “If the spending limit is reached at a particular vendor, and the user attempts a further purchase, an on-line authentication is performed with the user’s PP, as shown in page 293, figure 7.37”).

23. NewGenPay does not explicitly disclose:

24. generating and transmitting to the authentication and payment server, by the service providing server, the authentication and payment message that is sent to the authentication and payment server after the requested service has been provided to the wireless terminal apparatus and before a next service is provided to the wireless terminal apparatus, when the comparing determines that the amount of payment of the requested service is less than or equal to the reference amount.

25. iKP teaches:

26. generating and transmitting (page 260, figure 7.25, "Clear-Request") to the authentication and payment server (page 260, figure 7.25, "Acquirer"), by the service providing server (page 260, figure 7.25, "Merchant"), the authentication and payment message (page 264 - "merchant...composes a Clear-Request message") that is sent to the authentication and payment server after the requested service has been provided to the terminal apparatus (page 260, figure 7.25, "Goods and Services"; said goods and services have already been provided to the customer before the Clear-Request is sent) and before a next service is provided to the terminal apparatus (the Merchant computer cannot process any more transactions until it has sent the Clear-Request), when the comparing determines that the amount of payment of the requested service is less than or equal to the reference amount (page 260, "merchant accumulates the coupons deposited by the customer until...the merchant is satisfied that the merchant has accumulated enough coupons to warrant sending a Clear-Request to the acquirer").

27. iKP teaches sending a Clear-Request after every transaction in order to guarantee that the customers' coupons are valid; the Merchant computer waits to receive the "Clear-Response" message to figure out "whether the payment transaction was successful or not" (page 264, ¶2). NewGenPay acknowledges that one problem with NewGenPay is that a lack of communication with a "payment provider during each purchase...can allow user overspending with post-fact detection" (page 296). By using the Clear-Request/Clear-Response system in iKP in the NewGenPay system, the NewGenPay system becomes more reliable and less susceptible to malicious overspending; users would not be able to spend money that they do not actually have. This, in turn, creates a more profitable system, because implementers would be more likely to



purchase and use a system that does not permit others to spend money that they do not actually have.

28. Therefore, it would have been obvious to a person having ordinary skill in the art to include in NewGenPay the Clear-Request/Clear-Response system as taught by iKP, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more reliable and profitable system.

29. As per claim 15, NewGenPay in view of iKP discloses as above, but does not explicitly disclose: a wireless terminal apparatus.

30. It is now Admitted Prior Art (under MPEP §2144.03 C) that wireless terminal apparatuses was old and well-known in the art because they allow for a more convenient and robust system of transmitting data. By allowing users to use a mobile device, they are not tied to a specific desk or computer and may roam freely - creating a more convenient system. This also enables different paradigms for accessing services; a user would not be able to bring his desktop computer to a merchant's brick-and-mortar store, so by making the system able to be used on a wireless device, the system becomes more widely-usable. This, in turn, would create a more profitable system for its creators, because a system that is more convenient and more widely-usable is a system that users would be more likely to purchase and use.

31. Therefore, it would have been obvious to a person having ordinary skill in the art to include in NewGenPay and iKP the concept of a wireless terminal apparatus, since the claimed

invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more convenient, widely-usable, and profitable system.

***Response to Arguments***

32. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

33. Applicants' attempt at traversing the Official Notice findings as stated in the previous Office Action (Paper No. 20091209, Paragraph No. 17-20) is inadequate. Adequate traversal is a two step process. First, applicants must state their traversal on the record. Second, and in accordance with 37 C.F.R. §1.111(b), which requires applicants to specifically point out the supposed errors in the Office Action, applicants must state why the Official Notice statements are not to be considered common knowledge or well known in the art.

34. In this application, Applicants have failed both step (1) and step (2); there is no express statement challenging the Official Notice, and no arguments are presented as to why the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicants' traversal is inadequate, the Official Notice statements are taken to be admitted as prior art. See MPEP §2144.03.

***Conclusion***

35. Applicant's amendment, filed on 19 March 2010, necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

36. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

37. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The Examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

38. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621